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#13 / Petition

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FACSIMILE TRANSMISSION		
From: <u>William I. Solomon</u> Client/Matter No.: 520.30414V22		Date: September 17, 2003 No. of Pages : <u>14</u> (including cover sheet)
Deliver To	Facsimile Number	Reference Number
Examiner Pamela Wilson GAU: 3749	703/746-3482	09/766,596

☐ Urgent ☐ For Review ☐ Please Comment ☐ Please Reply

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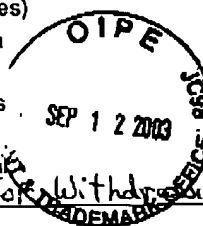
Confirmation Copy will follow.

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Patent Dkt. No. 520.30414 V22 Attorney Initials WIS
Application No. 09/766,596 Filing Date 1/23/01
Applicant(s) KATO, et al.
Papers Filed Herewith on SEPTEMBER 12, 2003

Receipt is hereby acknowledged of the papers filed as indicated by the checked items in connection with the above-identified application:

- ☐ New Application Transmittal Form ☐ Credit Card Payment Form
 Pages of Specification (claims) Fees \$
 Sheets of Drawings ☐ Amendment
☐ Declaration (pages) ☐ Response to Office Action
☐ Fee Transmittal Form ☐ Petition for Extension of Time (mos.)
☐ Claim for Priority ☐ Information Disclosure Statement
 ☐ Priority Documents ☐ PTO-1449 ☐ Copies of References
☐ Assignment Papers ☐ Revised Drawings (sheets)
☐ Issue Fee Transmittal ☐ Notice of Appeal
☒ Other Petition For Withdrawal... and enclosures



520.30414V22

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: KATO, et al.
Application No.: 09/766,596
Filed: January 23, 2001
For: VACUUM PROCESSING APPARATUS AND OPERATING
METHOD THEREFOR
Group: 3749

**PETITION FOR WITHDRAWING ANY POSSIBLE ABANDONMENT OF THE ABOVE-
IDENTIFIED AND TO ISSUE A NEW NOTICE OF ALLOWANCE AND FEE(s) DUE
WITH A CORRECT MAILING ADDRESS AND CORRECT CUSTOMER NUMBER**

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

September 12, 2003

Sir:

The telephone communication from Examiner Wilson on or about September 4, 2003, in connection with the above-identified application, is noted. During this telephone communication, the Examiner referred to a Notice of Allowance and Fee(s) Due mailed December 18, 2001, in connection with the above-identified application; and that apparently this Notice of Allowance and Fee(s) Due mailed December 18, 2001 had never been responded to. The Examiner is thanked for this telephone communication.

In view of this telephone communication, the undersigned requested that the Examiner transmit a copy of the Notice of Allowance and Fee(s) Due mailed

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December 18, 2001, to the offices of the undersigned, for an investigation as to whether such Notice of Allowance and Fee(s) Due mailed December 18, 2001 was ever received in the offices of the undersigned. The Examiner cooperated with this request, sending a copy of this Notice of Allowance mailed December 18, 2001, to the offices of the undersigned by facsimile.

As will be established in the following, it is respectfully submitted that an original mailing of this Notice of Allowance and Fee(s) Due mailed December 18, 2001, was never received in the offices of the undersigned attorneys; and, moreover, that a Notice of Abandonment was never received in the offices of the undersigned. This is clearly supported by the incorrect mailing name and address set forth on the Notice of Allowance and Fee(s) Due mailed December 18, 2001, transmitted to the following:

Mitchell P Brook
c/o Baker & McKenzie
101 Broadway
Suite 1200
San Diego, CA 92101,

as well as the incorrect customer service no. (024057, as compared with the correct customer service no. of ⁰²⁰⁴⁵⁷~~240457~~) on this Notice of Allowance mailed December 18, 2001.

Accordingly, pursuant to Manual of Patent Examining Procedure (MPEP) § 711.02 and the Commissioner's notice in 1156 OG 53, it is respectfully petitioned that any possible holding of abandonment be withdrawn and that a new Notice of Allowance and Fee(s) Due be mailed in connection with the above-identified application, after consideration of the various papers filed in the above-identified application after May

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29, 2001 (that is, amendments to the claims as in the Further Supplemental Preliminary Amendment filed January 14, 2002 and in the Supplementing Preliminary Amendment filed March 13, 2003; and the documents submitted in the Information Disclosure Statements respectively submitted February 6, 2002, July 15, 2002 and February 20, 2003).

It is respectfully submitted that issuance of a new Notice of Allowance, after consideration of the above-referred-to papers, is mandated based on the rationale set forth in Delgar, Inc. v. Schuyler, 172 USPQ 513 (DDC 1971).

It is respectfully submitted that the incorrect firm name and address, and incorrect customer service number, on the Notice of Allowance mailed December 18, 2001, provides sufficient basis for the conclusion that this Notice of Allowance mailed December 18, 2001, was not received in the offices of the undersigned. Moreover, as for additional reasons for granting this Petition, the following facts are respectfully submitted.

In the offices of the undersigned attorneys, all mail which is received from the U.S. Patent and Trademark Office (PTO) is given directly to a docketing department. Responsive to receipt of such mail, as a first safeguard, the docketing department maintains a computer database which stores information relating to the filing of papers in the PTO, receipt of papers from the PTO, and due dates for responding to papers received from the PTO. The data in the computer database is backed up on a magnetic tape at the end of each work day.

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Attached hereto is a printout of pertinent data in the computer database for the present application. The attached printout shows data fields entitled "Action", "Base", "Due In", "Due", "Final", and "Response" which will be discussed below.

When a paper which must be responded to is received from the PTO, the docketing department enters the mailing date of such paper in the "Base" data field. The description of the paper is set forth in the "Action" data field, and would be "Issue Fee" if the paper is a Notice of Allowance. The "Due" data field is the period for response, the "Final" data field being the final date for response; for the Issue Fee, the same date would normally be set forth for both the "Due" data field and "Final" data field, in view of the 3-month non-extendable period.

As can be seen in the enclosed computer printout for the above-identified application, there are a number of indications that various papers have been filed, including a Supplementing Preliminary Amendment on March 13, 2003; an Information Disclosure Statement (IDS) filed February 20, 2003; an IDS filed July 16, 2002; an IDS filed February 6, 2002; a Supplemental Preliminary Amendment filed January 14, 2002; a Supplemental IDS filed July 6, 2001 and an Information Disclosure Statement and Supplemental Preliminary Amendment filed May 29, 2002.

As can be seen in the enclosed computer printout, a Notice of Allowability is set forth with a "Base" of September 4, 2003; however, this is the copy of the Notice of Allowability attached to the Notice of Allowance mailed December 18, 2001, transmitted by the Examiner to the offices of the undersigned on September 4, 2003. As can be seen from the enclosed printout, there is no indication of receipt of a Notice of Allowance mailed December 18, 2001, around December 18, 2001.

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For the Notice of Allowance mailed December 18, 2001, the expiration date of a non-extendable statutory period for payment of the Issue Fee would be March 18, 2002. Therefore, if the Notice of Allowance mailed December 18, 2001, had been received in the offices of the undersigned attorney, the docketing department would have added "Issue Fee" under "Action"; a "Base" of December 18, 2001; a "Due" of March 18, 2002; and a "Final" of March 18, 2002. However, as can be seen from the attached printout, this is not set forth, indicating that the Notice of Allowance mailed December 18, 2001, was never received in the offices of the undersigned attorney.

Furthermore, as a safety cross check against the computer database, the docketing department maintains a handwritten master docket book which has one page for each day of the year.

After data relating to a PTO paper has been entered into the computer database, the docketing department handwrites data relating to such paper into the master docket book on the page corresponding to the expiration date of a maximally-extended statutory period for response to the paper. As discussed above, for the Notice of Allowance mailed December 18, 2001, the expiration date for payment of the Issue Fee would be March 18, 2002.

Attached hereto is a copy of the master docket book for March 18, 2002. When the Notice of Allowance is received, the docketing department enters the following information in the master docket book on the page corresponding to the expiration date of the last possible date for response: the docket number of an application to which the PTO action pertains; the last name of the first-named inventor of the application; the

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serial number of the application; the notification "Issue fee" and, if also due, "pub fee" (for publication fee); and the initials of the attorney to whom the application is assigned.

Therefore, if the Notice of Allowance mailed December 18, 2001 had been received in the offices of the undersigned attorneys, the attached copy of the page of the master docket book for March 18, 2002 would show an entry with the following data: docket no. 520.30414V22; the last name "Kato"; Serial No. 766,596; the notation "Issue Fee" and "pub fee"; and the initials "WIS". However, as can be seen from the attached copy of the page of the master docket book for March 18, 2002, such an entry does not appear.

While entries for related applications (Serial No. 780,394; No. 781,452; and No. 780,427) do appear, it is again emphasized that there is no entry for Serial No. 766,596.

It is respectfully submitted that the absence of entries on the master docket book page for March 18, 2002, further evidences the fact that the Notice of Allowance mailed December 18, 2001 was never received in the offices of the undersigned attorney.

It is again noted that the copy of the Notice of Allowance mailed December 18, 2001, sent to the offices of the undersigned on September 4, 2003 by the Examiner, has a mailing address to the following:

Mitchell P Brook
c/o Baker & McKenzie
101 Broadway
Suite 1200
San Diego, CA 92101,

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and a customer service number of 024057. Clearly, the U.S. Patent and Trademark Office erred in mailing the Notice of Allowance on December 18, 2001 to an incorrect address, and in setting forth an incorrect customer service number for the above-identified application; and it is likely that these errors by the U.S. Patent and Trademark Office were the cause of the failure of the Notice of Allowance to be received in the offices of the undersigned.

It is noted that, as seen on the enclosed computer records for the above-identified application, various papers have been filed in the above-identified application after December 18, 2001; and, in fact, after March 18, 2002. For example, a Supplemental Preliminary Amendment was filed January 14, 2002; Information Disclosure Statements were filed February 6, 2002, July 16, 2002 and February 20, 2003; and another Supplementing Preliminary Amendment was filed March 13, 2003. It is respectfully suggested that the U.S. Patent and Trademark Office should have, prior to September 4, 2003, notified Applicants that the Notice of Allowance had been mailed December 18, 2001. Furthermore, it is also noted that Applicants have never received a Notice of Abandonment in the above-identified application. It is respectfully submitted that the present Petition is timely, particularly in light of failures and errors by the U.S. Patent and Trademark Office, in failing to notify Applicants of the Notice of Allowance mailed December 18, 2001, until September 4, 2003, and is still not notifying Applicants (e.g., by a Notice of Abandonment) of the abandonment of the above-identified application.

Furthermore, upon a full review by the undersigned of the file of the above-identified application that is in the offices of the undersigned, it is hereby stated by the

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undersigned that a copy of the Notice of Allowance mailed December 18, 2001, other than a copy thereof sent to the undersigned by the Examiner on September 4, 2003, is not in the application file.

For reasons discussed above, it is respectfully submitted that the Notice of Allowance and Fee(s) Due mailed December 18, 2001, was never received in the offices of the undersigned attorney. Accordingly, pursuant to Manual of Patent Examining Procedure 711.02 and under the rationale set forth in Delgar, Inc. v. Schuyler, 172 USPQ 513 (DDC 1971), it is respectfully petitioned that any holding of abandonment be withdrawn, and that a new Notice of Allowance be issued with a mailing date of the date of actual mailing of the new Notice of Allowance, and that all papers having been filed in the above-identified application before the date of mailing of the new Notice of Allowance be entered in and considered in the above-identified application as a matter of right.

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To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Case No. 520.30414V22), and please credit any excess fees to such Deposit Account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

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WIS:sjg

2002 17th day 239 days

MONDAY 18 MARCH

1055.39235X00	4956964	mainfo	RES bnp plom
525.26732X00	4957350	mainfo	ALK
321.26876X00	4957581	mainfo	RES other
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526.37152X00	4958012	Response	Ego cur 11/18
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20.40	501.337450x2	file cont app	31/8	31/8	31/8
20.40	506.355620x1	file cont app	31/8	31/8	31/8
13.30	520.383670x0	file cont app	31/8	mk	2-9/25
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3632700	Sano	090454	WIS
3724000	D. Agn	81066	WIS
3450000			WIS

09/17/2003 10:51 FAX

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OPER **WSM** ENTERED **11/30/2000** MODIFIED **2003** ATTORNEYS **WIS / WIS / DKT** PRINTED ON: **9/10/2003**
 ATSK# **520.30414V22** CNTRY **US** UNITED STATES NEW/CON **CON** RELATED **503.30414C19**
 PATS# **P16787USB** TYPE **UTL** SERIAL# **09/766,596** PATENT# STAT **PENDING**
 TITLE **VACUUM PROCESSING APPARATUS AND OPERATING METHOD THEREOF***LET WIS KNOW WHEN IF COMES IN***** RL/FM
 CLIENT **520** **NITTO IPO LTD.** **1** CREF **NTT045US-25** SE ART
 AGENT AREF CLAIMS **00221906**
 PRIOR MAIL **1/23/2001** FILE **1/23/2001** PUBL ISSUE EXP **10/23/2018** 1ST **10/23/1998**

ID	O	ACTION	BASE	DUE IN	DUE	EXTNS	FINAL	EXT	RESPONSE	CALL	1	2	P
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	Y	IDS/SUPP PRELIM FLD	5/29/2001										
	Y	SUPPL IDS FILED	7/6/2001										
	Y	SUPP PRE AMEND FILED	1/14/2002										
	Y	IDS FILED	2/6/2002										
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	Y	ids filed	2/20/2003										
	Y	SUPPL PRELIM AMNDT	3/13/2003										
	Y	NOT OF ALLOWBILTY	9/4/2003										
SENT BY FAX BY EXAMINER													

PRIOR APPLICATIONS

REFERENCE#	CNTRY	SERIAL#	FILED	TITLE / DESCRIPTION	TYPE
503.30414C19	US			VACUUM PROCESSING APPARATUS AND OPERATING METHOD THEREOF	APPL

NOTES

12/04/01 FAX/COMMS/INSTR
 01/17/02 LTR/COMMS/INSTR
 03/26/02 FAX/COMMS
 04/18/02 FAX/COMMS RE EXAM RESULTS
 12/27/02 FAX/FILE IDS-NO DUE DATE
 1/16/03 FAX/FILE IDS-NO DUE DATE
 1/17/03 LTR/CONFIRM FAX
 2/10/03 FAX/COMMS
 2/13/03 LTR/CONFIRM FAX
 02/19/03 FAX/AMEND CLAIMS
 2/25/03 LTR/CONFIRM FAX
 2/27/03 FAX/COMMS/INSTR
 3/4/03 LTR/CONFIRM FAX
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 9/4/03 FAX/FILE 2 DIV APPS